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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/876,322	06/16/1997	DAVID J. ROBSON	7:ROBSON-CON	4900

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INDIANAPOLIS, IN 46204

EXAMINER

CINTINS, IVARS C

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/876,322

Applicant(s)

ROBSON ET AL.

Examiner

Ivars C. Cintins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-6, 8-15, 17, 20 and 24-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-30 and 32 is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 8-15, 20, 24, 25 and 31 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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This application fails to contain claims numbered "29" and "30." Accordingly, claims 31-34 have been renumbered as claims 29-32, respectively, in accordance with 37 CFR 1.126.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "the oils" (claim 31, line 3) lacks antecedent basis in the claims, since parent claim 26 recites "hydrophobic water-immiscible liquids," not "oils," and is therefore indefinite. Applicant is advised that an amendment changing "oils" to "hydrophobic water-immiscible liquids" in line 3 of claim 31 would overcome this rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 8-15, 20, 24 and 25 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Sohnius (U.S. Patent No. 3,607,741) in view of published European patent application EP 0 213 252 A1. As pointed out in the previous Office Action, Sohnius discloses the claimed invention with the exception of the specific cellulosic material employed. Published European patent application EP 0 213 252 A1 discloses treating a lignocellulosic material in the recited manner, and further teaches (col. 1, lines 6-8) that such treatment increases the dimensional stability of the lignocellulosic material, and also improves its resistance to biological degradation. Since both of these characteristics would obviously be desirable for the

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material of Sohnius, particularly since this reference material will be used in open and rough bodies of water (col. 1, line 21), it would have been obvious to one of ordinary skill in the liquid purification art to substitute the treated lignocellulosic material of published European patent application EP 0 213 252 A1 for the cellulosic material of Sohnius, in order to obtain the advantages disclosed by this secondary reference for the system of the primary reference.

Claims 26-30 are allowed because the references of record do not teach or fairly suggest treating a mixture of the type recited with a material consisting essentially of wood fiber which has been modified by esterification of hydroxyl groups in the lignin of this wood fiber. Claim 32 is allowed because the references of record do not teach or fairly suggest treating a mixture of transformer oil and water with a paper material which has been modified by esterification of hydroxyl groups in the lignin of this paper material. Claim 31 would also be allowed if rewritten or amended to overcome the above rejection under 35 U.S.C. § 112.

Claim 17 is objected to, under 37 CFR § 1.75, as being a substantial duplicate of allowed claim 32. See M.P.E.P. § 706.03(k).

Applicants' arguments filed May 20, 2004 have been noted and carefully considered but are not deemed to be persuasive of patentability. Applicant argues that comparing the material of Sohnius to this same material treated according to the claimed invention would be difficult because: (1) the material of Sohnius is difficult to prepare; and (2) Applicant is not sure at what point should the wood fiber/paper pulp be treated according to the claimed invention. As to item (1), Applicants should attempt to produce this reference material by combining its components in the amounts disclosed in this reference as best they can. As to item (2), Applicants should modify the starting lignocellulosic plant material (i.e. wood and paper), by esterification of

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hydroxyl groups therein, prior to the water repellent treatment, in order to demonstrate that any new and unexpected results obtained are derived from such a modification treatment, and not from any other factors.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (571) 272-1155. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Blaine Copenheaver, can be reached at (571) 272-1156.

The centralized facsimile number for the USPTO is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
June 1, 2004